REMARKS

Claims 1-12, 14, 16-23, and 25-27 are pending in the present application. Claims 13 and 24 are canceled. Reconsideration of the claims is respectfully requested.

I. Asserted Obviousness of Claims 1-14 and 16-27

The examiner rejects claims 1-14 and 16-27 as obvious over McCurdy et al., System and Methods for Distributing and Viewing Electronic Documents, U.S. Patent Publication No. 2002/0035697 (Mar. 21, 2002) (hereinafter "*McCurdy*") in view of Kohler, Electronic Mail With Recipient-Specific Content, U.S. Patent No. 6,192,396 (Feb. 20, 2001) (hereinafter "*Kohler*") . This rejection is respectfully traversed.

In rejecting claim 1, the examiner states that:

> With respect to claim 1, McCurdy teaches receiving a user input selecting the text from the electronic book to form selected text (a user enables to receive/obtaining the electronic document or text from the reader device such as electronic book or PDA or notebook or laptop computers and selecting or highlight the text and sending to the recipient: section 0159, 061-0163 and 0176-0177; highlighting the text: sections 0213- 0216; also see fig. 8).
>
> McCurdy teaches distributing and viewing electronic documents via a reader device such as electronic book or e-book, PDA (sections 0004 and 0014), laptop, notebook and handheld (sections 0078 and 0084), sharing the content of electronic documents (sections 0177 & 0222); receiving or obtaining the text or electronic document from the reader and selecting or highlighting the portion of the text or electronic document (sections 0159, 0161 -0163 and see fig. 8) and sending the text to the recipients (sections 0176-0177). McCurdy does not clearly teach automatically sending the selected text to each electronic book for a designated set of recipients in response to receiving the user input selecting the text.
>
> However, Kohler teaches the highlighted text /portions of message to be automatically sent to a designated as intended for selected recipients (col. 7, lines 26- 40 and col. 8, lines 1-10; also see col. 1, lines 60-67, col. 2, lines 1-40; also see abstract).
>
> Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of McCurdy with the teachings of Kohler, wherein the reader device gets or receives the electronic document from the user's inputting and selecting or highlighting the text or portion of the of text in the system provided therein (McCurdy's fig. 3, item 80 and fig. 8), would incorporate the use of automatically sending the highlighting text to a designated as intended for the selected recipients (col. 7, lines 26-40 and col. 1, lines 60-67 and col. 2, lines 1-40). The motivation being to enable the user automatically

> to send the selected/highlighted text/portion of text to a designated set of recipients from an electronic book reader device.

Office Action dated May 10, 2005, pages 3-4.

If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). A prima facie case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). A proper *prima facie* case of obviousness cannot be established by combining the teachings of the prior art absent some teaching, incentive, or suggestion supporting the combination. *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995); *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990).

I.A. The Examiner Has Failed to State a Prima Facie Obviousness Rejection Against Claim 1

The examiner has failed to state *a prima facie* case of obviousness with respect to claim 1 because the features that the examiner states as being present in the references are not found or suggested by the references, and because the examiner has failed to provide a proper motivation to modify or combine the references. Applicants address each of these facts in turn.

I.A.1. All of the Features of Claim 1 Are Not Present in the Cited References

First, the features that the examiner states as being present in the references are not found or suggested by the references. Claim 1 reads as follows:

> 1. A method in a data processing system for sharing text in an electronic book, the method comprising:
> receiving a user input selecting the text from the electronic book to form selected text; and

> automatically sending the selected text to each electronic book for a designated set of recipients in response to receiving the user input selecting the text.

Neither *McCurdy* nor *Kohler* show or suggest, individually or in combination, the claimed step of *automatically* sending selected text to each electronic book for a designated set of recipients in response to receiving the user input selecting the text.

The examiner admits that *McCurdy* does not teach the claimed step of automatically sending the selected text to each electronic book for a designated set of recipients in response to receiving the user input selecting the text. The examiner next asserts that *Kohler* teaches sending highlighted text/portions of a message automatically to designated recipients in col. 7, lines 26-40; col. 8, lines 1-10; col. 1, lines 60-67; col. 2, lines 1-40; and the abstract. Office Action of May 10, 2005, p. 3. However, the examiner's interpretation of this cited reference is incorrect.

The examiner first cites the following portion of *Kohler*:

> In order to select or deselect recipients, the user preferably points to a recipient using cursor 53, and then selects or deselects that recipient by clicking on the left button of pointing device 14. In the preferred embodiment, changes in any one of the sections are reflected in the other sections. For example, if the "To:" category in category selection section 63 is selected, the corresponding individual recipients in individual selection section 62 have check marks automatically displayed next to them, indicating that they have been selected. Optionally, if some but not all of the recipients for a category have been designated as recipients of the selected part of the message, a special mark (for example, a gray, rather than black, check mark) can be displayed next to that category.

Kohler, col. 7, lines 26-40. As can be seen, this portion of *Kohler* teaches selecting categories of recipients for a selected portion of a message. *Kohler*, however, makes no mention of automatically sending selected text to a designated set of recipients, as recited in claim 1.

The examiner next cites the following portion of *Kohler*:

> In an alternative embodiment, recipients are associated with text by first selecting intended recipients. This selection can be made in a similar fashion as described above. Then, subsequently-entered text is automatically designated as intended for the selected recipients. If the user subsequently selects a different recipient or recipients, text entered

> following that designation is associated with those recipients. This process is repeated until the message is complete. In addition, the user can select already-entered text and modify the recipients of that text, as described above.

Kohler, col. 8, lines 1-10. This cited portion of *Kohler* teaches first selecting intended recipients, and then subsequently entered text is automatically designated as intended for the selected recipients. The term "designated" in *Kohler* refers to associating the subsequently-entered text as being intended for the selected recipients. However, *automatically designating* text as intended for selected recipients is different from *automatically sending* selected text for a designated set of recipients, as recited in claim 1. Thus, this portion of *Kohler* thus does not teach *automatically sending* selected text, as recited in claim 1.

The examiner also cites from *Kohler* as follows:

> After the author has created the list of recipients, any portion or portions of the message which are to be sent only to certain recipients are selected, such as with a pointing device or with key strokes. A list of available recipients is provided to the sender for selection, such as with a "pop-up" menu. The recipients for the selected text are then selected (or selected ones can be deselected, if desired).

Kohler, col. 1, lines 60-67. As can be seen, this portion of *Kohler* teaches creating a list of recipients, selecting portions of the message which are *to be sent* only to certain recipients, and selecting or deselecting recipients for the selected text. However, this portion of *Kohler* also makes no mention of *automatically sending* selected text to a designated set of recipients in response to receiving the user input selecting the text, as recited in claim 1.

The examiner also cites from *Kohler* as follows:

> A computerized messaging system which authors messages that contain recipient-specific content, such that each recipient does not necessarily receive a message that is identical to all other recipients. To author a computerized message that contains recipient-specific content, plural portions of the message are authored, and one or more recipients to which at least one portion of the message will be sent are identified. For each recipient, at least one portion of the message is associated with the recipient, such that at least one recipient does not receive all portions of the message. Viewing options are provided to the sender so as to enable

> the sender to obtain visual cues as to which portions of the message are sent to each recipient or set of recipients, or to allow the sender to view a recipient list for selected portions of the message. At the receiving side, a recipient can view a received message with visual cues such that recipients of private portions of a message can know that others did not receive the private portion, and can further know who received which portions.

Kohler, Abstract. In the Abstract, *Kohler* teaches authoring plural portions of a computerized message and associating at least one portion of the message with each recipient. *Kohler* thus teaches authoring a computerized message, which is different than sharing text in an electronic book, as recited in claim 1. *Kohler* teaches authoring plural portions of a message and associating one portion of the message with each recipient, which is different than automatically sending selected text to each electronic book for a designated set of recipients in response to receiving the user input selecting the text, as recited in claim 1. Nowhere does this cited section teach that the selected text is automatically sent in response to receiving user input selecting the text. Therefore, *Kohler* does not show or suggest the features of claim 1, as asserted by the examiner. In addition, *Kohler* does not elsewhere show or suggest the claimed features, as asserted by the examiner.

The step of automatically sending selected text to each electronic book for a designated set of recipients in response to receiving the user input selecting the text is not shown or suggested by *Kohler* as believed by the examiner. For this reason, the cited references do not show or suggest all the features of claim 1. Therefore, the proposed combination of the cited references does not reach the claimed invention of claim 1. The examiner has accordingly failed to state a *prima facie* obviousness rejection with respect to claim 1.

I.A.2. The Examiner Has Failed to State Proper Motivation to Combine the References

In addition, assuming *arguendo* that *Kohler* does teach the automatic sending step, these two references cannot be combined as suggested by the examiner. In combining these two references, the examiner states:

> Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of McCurdy with the teachings of Kohler, wherein the reader device gets or receives the electronic document from the user's inputting and selecting or highlighting the text or portion of the of text in the system provided therein (McCurdy's fig. 3, item 80 and fig. 8), would incorporate the use of automatically sending the highlighting text to a designated as intended for the selected recipients (col. 7, lines 26-40 and col. 1, lines 60-67 and cot. 2, lines 1-40). The motivation being to enable the user automatically to send the selected/highlighted text/portion of text to a designated set of recipients from an electronic book reader device.

Office Action of May 10, 2005, p.4.

This statement is not a proper motivation to combine the references or to further modify the proposed combination to reach the present invention of claim 1. The examiner has only presented an advantage to combining the two cited references. An advantage cannot be substituted for a motivation to combine references because an advantage is not necessarily a motivation. Just because it is advantageous to modify or combine does not mean there is motivation to perform the modification or combination.

For example, a first reference may disclose the use of lasers to achieve nuclear fusion. A second reference may disclose that an ultra-high power laser delivers more energy. One of ordinary skill may recognize that an ultra-high power laser would be more useful to achieve nuclear fusion, though one of ordinary skill would be motivated to avoid combining the references because of the extreme expense of ultra-high power lasers. In this example, one of ordinary skill is motivated to avoid implementing the combination, even if he or she recognized the advantage, and so no motivation exists to combine the references. In the case at hand, the examiner has not provided any reason why one of ordinary skill would recognize the proposed advantage or have a reason to implement it. For this reason, the examiner's statement fails to provide a proper motivation to combine the references. Accordingly, the examiner has failed to state a prima facie obviousness rejection.

Further, no teaching, suggestion, or incentive based on the prior art has been pointed out to combine these two references. The "motivation" presented is based only on the examiner's statement, and is without any teaching, suggestion, or incentive based

on the prior art. The examiner's motivation alone, without any teaching, suggestion, or incentive based on the prior art, is insufficient to combine these two references.

In other words, the examiner's statement is logically insufficient to make the suggested modification or combination because the examiner is using the feature itself as motivation. The examiner states that a person of ordinary skill in the art would combine the teachings of *McCurdy* and *Kohler* to enable the user to automatically send the highlighted text to a designated set of recipients, the motivation being to enable the user to automatically send the highlighted text to a designated set of recipients. The feature of claim 1 cannot itself be used as the motivation to combine the references. Therefore, the examiner has failed to state a proper motivation to combine the references.

Also, the examiner has failed to state a proper motivation because the reference does not teach the features that the examiner believes are disclosed. As established above, *Kohler* makes no mention of automatically sending selected text to each electronic book for a designated set of recipients in response to receiving the user input selecting the text, as recited in claim 1. Because this teaching is not present in *Kohler* or *McCurdy*, and because the examiner has not shown a motivation to further modify the proposed combination, the examiner has failed to supply a motivation based on the actual teachings of the references. Hence, the examiner has failed to state a proper motivation to combine the references and, accordingly, has failed to state a *prima facie* obviousness rejection against claim 1.

I.B. Claim 1 is Non-Obvious in View of *McCurdy* and *Kohler*

"It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Hedges*, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986). In viewing the references as a whole, one of ordinary skill would look to the problems addressed by the references in determining whether to combine the references. *McCurdy* and *Kohler* address different problems.

More specifically, *McCurdy* pertains to the problem of distributing and viewing electronic versions of printed documents such as magazines and books. Paragraphs 4-5 of *McCurdy* disclose:

> With the increased growth and popularity of the Internet, many publishers have been turning to distributing their publications in alternate formats, such as in online format, and/or via media such as compact disk read only memories (CD-ROMS). With this technique, a user can instead read the publication on the screen of his or her personal computer (PC). At the present time, however, despite the availability of such publications, consumers have been slow to accept reading from a computer screen. In response to the lukewarm response by consumers, makers of personal digital assistants (PDA) devices such as the Palm IV (available from Palm, Inc., 5470 Great America Parkway, Santa Clara, Calif.) and of electronic books (E-books) such as the ROCKET EBOOK and/or SOFTBOOK (available from NUVOMEDIA, Inc., 310 Villa Street, Mountain View, Calif.) have attempted to provide devices and systems that attempt to more closely simulate the experience of reading an actual book. These devices are small and lightweight, like most books, magazines, and newspapers, but still do not provide the same experience as reading all of these types of publications. Because the screen size on the PDA's and ROCKET EBOOKS is relatively small, it is difficult to put an entire page of a newspaper or magazine on the screen of either of these devices. In addition, neither device permits the reader to see the entire page exactly as it appears in the conventional published document. Also, these devices have low resolution and use proprietary software and or proprietary Internet-based language requirements.
>
> Another disadvantage of such devices is that publications made available on such devices must be translated and recomposed for their screens and systems. The ROCKET EBOOK, for example, calculates pages for each book depending on the font style, size and page orientation chosen. Because these factors make paging relative, the same book on different ROCKET EBOOK with different settings will have different page numbers. This feature, while acceptable for publications such as novels, is less satisfactory for publications having tables of contents, such as magazines and other periodicals. In addition, the page layout, colors, arrangement, illustrations, and even advertisements, form an integral part of the magazine's enjoyability and the convenience of the reading experience. These devices do not provide this type of experience during use.

McCurdy solves this problem by encrypting the electronic documents and providing a key to decrypt and view the documents. *McCurdy*, claim 1.

In contrast, *Kohler* pertains to the problem of recipient-specific content in computerized messaging. *Kohler*, Col, 1, lines 14-44 discloses:

> Current computerized messaging systems provide for the ability to send a computerized message to more than one recipient. Such systems are limited, however, in that each recipient receives the identical message. This is inconvenient, for example, in a situation where it is desired to send a private comment to some but not all of the recipients.
>
> For example, in an electronic mail ("E-mail") messaging system, the sender authors a text message, with or without attachments, that can be sent to recipients in any of three categories: a "To:" category, a "cc:" category, and a "bcc:" category. As is known, the "To:" category is for the directly-intended recipient or recipients, the "cc:" category is for courtesy-copy recipients who are included for information, and the "bcc:" category is for blind-courtesy-copy recipients who are intended to receive the message without other recipients being aware of their receipt. However, even with the above addressing categories, what is received by each recipient is the entire text of the message and all attachments. Thus, each recipient receives the identical message.
>
> In some situations, the sender wishes to forward some portions of a message only to certain recipients and not to others. For example, a sender may desire to include private comments in the E-mail message, with the private comments being readable only by bcc recipients. However, since current E-mail systems send the identical message to each and every recipient, it is necessary for the sender to create two different E-mail messages, and to select which message is to be sent to which recipient. This arrangement is cumbersome and time-consuming, and inevitably leads to errors.

Kohler solves this problem by having a sender author plural portions of a message and then having the sender associate at least one portion of the message with each recipient. *Kohler*, Abstract. These two problems, distributing electronic versions of magazines and books, and sending emails with recipient-specific content, have nothing to do with each other. Likewise, the proposed solutions to the problems have nothing to do with each other. Thus no one of ordinary skill would have reason or motivation to look to *Kohler* for problems that arise in *McCurdy* or vice-versa. Accordingly, claim 1 is non-obvious in view of the cited references when the references are considered as a whole.

In addition, the invention of claim 1 pertains to the problem of collaboration using an electronic book. The invention of claim 1 solves the problem of sharing information gathered from the electronic book by allowing a user to highlight and tag passages and/or notes, and automatically sending the selected text to a designated set of recipients.

Specification, Abstract, and claim 1. The problem addressed by the invention of claim 1 and the solution provided by the invention of claim 1 are unrelated to the problems addressed by *McCurdy* or *Kohler* and their proposed solutions are also unrelated to the solution represented by claim 1. Thus, no one of ordinary skill would be motivated to look to either *McCurdy* or *Kholer* to solve the problem addressed by the invention of claim 1. Similarly, no one of ordinary skill would be motivated to combine either *McCurdy* or *Kholer* or to further modify the combination to achieve the features of claim 1. Accordingly, claim 1 is non-obvious in view of the cited references when the references are considered as a whole.

I.C. Remaining Claims

Claims 14, 23, and 25-27 contain limitations similar to those presented in claim 1 and therefore the examiner has failed to state a *prima facie* obviousness rejection against claims 14, 23, and 25-27 for the reasons presented above. Similarly, claims 14, 23, and 25-27 are non-obvious for the reasons presented above.

These dependent claims also include other features not taught or suggested by the cited references. For example, claim 5 recites storing the selected text in a data structure, a feature not taught or suggested by the cited references.

The remaining dependent claims all depend from claim 1 and are therefore patentable over the cited references for the same reasons as those presented for claim 1. Therefore, the rejection of claims 1-12, 14, 16-23, 25-26 under 35 U.S.C. § 103(a) has been overcome.

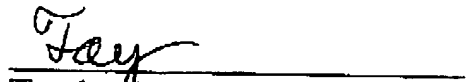
II. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: August 9, 2005

Respectfully submitted,



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